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REMARKS

Attached hereto on a separate sheet entitled "Version with markings to show changes made." is a version of the above amendments with the changes marked.

Claim disposition

Claims 1-13 and 15 are cancelled without disclaimer or prejudice, as explained below.

Claim 14 is amended as explained below.

New claims 16-20 are added.

Claims 14 and 16-20 are now pending in the application.

Election/Restriction

Applicants acknowledge the finality of the election to prosecute the invention of Group VI, claims 13-15, drawn to human polypeptides. Accordingly, claims 1-13 are cancelled as set forth above, in response to the present restriction requirement. Applicants hereby reserve the right to file Divisional applications or take any other such appropriate measure to prosecute the invention of the non-elected claims. It is further noted that Applicants made a timely election with traverse, as set forth in paper No. 8.

The Claim Objections should be withdrawn

Claims 14 and 15 were objected to, due to the recitation of "SEQ ID n^o". Consistent with the amendments set forth above, these recitations are appropriately corrected to "SEQ ID NO:".

Claims 14 and 15 were objected to, due to the recitation of porcine sequences as belonging to a non-elected group. Claim 14 is amended to exclude the recitation of SEQ ID NO:5; and the subject matter of cancelled claim 15 as presented in the new claims excludes the recitation of the porcine sequences. Applicants hereby reserve the right to file Divisional applications or take any other such appropriate measure to prosecute the invention of the non-elected group.

Accordingly, Applicants respectfully request that the present objections be withdrawn.

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The rejection under 35 U.S.C. § 112, first paragraph, should be withdrawn

Claims 13-15 were rejected under 35 U.S.C. § 112, first paragraph, for nonenablement.

While the Office Action acknowledges that the specification is enabling for an isolated polypeptide comprising SEQ ID NO:14-17, the Office Action indicates that the claims are not reasonably enabled for an isolated polypeptide comprising the amino acid sequence of a secreted soluble $\alpha_2\delta$ -1 polypeptide or an isolated polypeptide comprising the amino acid sequence with at least 80% SEQ ID NO:14 or a sequence complementary thereof. The Office Action further indicates that the ordinarily skilled artisan is not enabled to make the invention commensurate in scope of the claims.

To facilitate prosecution and allowance of the claims under consideration, claims 13 and 15 are cancelled, claim 14 is amended; and new claims are added. Support for these amendments are found throughout the specification and the original claims. Subject matter directed to the elected sequences of cancelled claim 15 is presented in new claims 17 and 20.

Claim 14 is amended to exclude the inadvertently recited phrase "a sequence complementary thereto". Additionally, claim 14 is amended to include a limitation drawn to a recombinant polypeptide comprising an amino acid sequence having at least 80% amino acid identity with a polypeptide having a specified range of amino acid residues set forth in SEQ ID NO:14. In addition, claim 14 is amended to include a limitation drawn to set forth that the purified or isolated recombinant polypeptide is a soluble secreted $\alpha_2\delta$ -1 subunit polypeptide. The specification not only sets forth SEQ ID NO:14, but also provides guidance as to the appropriate range of amino acids within SEQ ID NO:14 that can be utilized by the ordinarily skilled artisan in making the claimed polypeptides under consideration. See for example, page 17, first two paragraphs. Furthermore, the specification teaches modification of the polypeptides of the invention by equivalent amino acid substitution, and/or tagging. See for example, page 16, lines 15-24; page 17, line 25, to page 18, line 30. Furthermore, Applicants respectfully note that extensive experimentation is not undue experimentation. Thus, Applicants submit that with the guidance provided in the specification, it would be well within the skill of the ordinarily skilled artisan to make the claimed polypeptides under consideration and test whether they are a secreted soluble polypeptide.

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Furthermore, with respect to the comments in the Office Action regarding the lack of guidance as to functional testing of the variants of the invention, Applicants first respectfully note that a working example of every permutation of the invention is not required; and that extensive experimentation is not undue experimentation. Furthermore, Applicants submit that the specification does provide the requisite guidance as to functional testing of the polypeptides of the invention. For example, see page 6, and Example 6 with respect to [³H]Gabapentin binding. Applicants further submit that particular methods for assaying for Gabapentin binding were well known in the art, at the time of filing the present application. See for example, Gee et al. (1996) reference of record, a copy of which was submitted by Applicants on January 27, 2000; and also cited on page 26. Applicants further note that the "specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public". See MPEP 2164.05 (a), paragraph 6.

Accordingly, Applicants submit that this rejection of the claims under consideration is obviated. Therefore, Applicants respectfully request that this rejection under 35 U.S.C. § 112, second paragraph, be withdrawn and not extended to the new claims.

The rejection under 35 U.S.C. § 102 should be withdrawn

Claims 13-15 were rejected under 35 U.S.C. § 102 (b) as being anticipated by Harpold et al., U.S. Patent No. 5,429,921. In support, the Office Action states that Harpold et al. "disclose polypeptides comprising SEQ ID NO:25 amino acid sequences which are 100% identical to claimed SEQ ID NO: 14-17".

In light of the amendments and the new claims set forth and explained above, the claims of the present invention under consideration each contain a limitation drawn to set forth that the claimed polypeptides of the invention are soluble secreted polypeptide. In contrast, Applicants submit that the polypeptide of Harpold et al. set forth in SEQ ID NO:25 therein, is not a soluble secreted polypeptide; as evidenced by Harpold et al.'s use of electrophysiological methods in assessing channel function subsequent to expression of this polypeptide. See for example, column 43, line 66, to column 48 of Harpold et al. See also column 10, second full paragraph of Harpold et al. Nowhere in this reference do Harpold et al. teach a secreted soluble polypeptide in relation to SEQ ID NO:25.

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Therefore, as each element of the claimed invention under consideration is not taught by Harpold et al., Applicants submit that the present claims under consideration are not anticipated by Harpold et al. Accordingly, Applicants respectfully request that this rejection of the claims be withdrawn and not extended to the new claims.

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is respectfully solicited.

The Commissioner is hereby authorized to charge any fees under 37.C.F.R §§ 1.116 and 1.117 that may be required by this paper to Deposit Account No: 23-0455.

In the event the Examiner wishes to discuss any matter concerning this application, he is welcomed to communicate with the undersigned by telephone. In the event that attempts to reach the undersigned by telephone is unsuccessful the Examiner is welcomed to contact the attorney of record, Mr. Charles Ashbrook, at 734-622-5215.

Respectfully submitted,

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Version with markings to show changes made.IN THE CLAIMS:

Claims 1-13 have been cancelled.

14) (Amended) [A recombinant polypeptide according to claim 13, having] A purified or isolated recombinant polypeptide comprising an amino acid sequence having at least 80% amino acid identity with a polypeptide [comprising] having an amino acid sequence from amino acid 1 to between amino acids 985 and 1054 of the amino acid sequence of SEQ ID NO:14 [SEQ ID N°5 or SEQ ID n°14, or a sequence complementary thereto]; wherein said purified or isolated recombinant polypeptide is a soluble secreted $\alpha_2\delta$ -1 subunit polypeptide.

Claim 15 has been cancelled.

New claims 16-20 are added as follows:

--16) A purified or isolated recombinant polypeptide comprising an amino acid sequence having at least 80% amino acid identity with a polypeptide having the amino acid sequence selected from the group consisting of the amino acid sequences of SEQ ID NO:15; SEQ ID NO:16; and SEQ ID NO:17; wherein said purified or isolated recombinant polypeptide is a soluble secreted $\alpha_2\delta$ -1 subunit polypeptide.

17) A purified or isolated recombinant polypeptide comprising an amino acid sequence selected from the group consisting of the amino acid sequences of SEQ ID NO:15; SEQ ID NO:16; and SEQ ID NO:17; wherein said purified or isolated recombinant polypeptide is a soluble secreted $\alpha_2\delta$ -1 subunit polypeptide.

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sequence from amino acid 1 to between amino acids 985 and 1054 of the amino acid sequence of SEQ ID NO:14.

19) A purified or isolated recombinant polypeptide that is a soluble secreted $\alpha_2\delta$ -1 subunit polypeptide, said polypeptide having at least 80% amino acid identity with a polypeptide having the amino acid sequence selected from the group consisting of SEQ ID NO:15; SEQ ID NO:16; and SEQ ID NO:17.

20) A purified or isolated recombinant polypeptide that is a soluble secreted $\alpha_2\delta$ -1 subunit polypeptide, said polypeptide having an amino acid sequence selected from the group consisting of SEQ ID NO:15; SEQ ID NO:16; and SEQ ID NO:17.--